

REMARKS

This Amendment is responsive to the Final Office Action of October 26, 2006. A request for extension of time and the appropriate fee are included.

Pending Claims

Prior to entry of this Response, Claims 1-7, 10 and 13-24 were pending and Claims 8-9, 11-12 and 25-27 stood withdrawn pursuant to Applicant's 10/7/05 election of claims in response to a restriction requirement. Subject to entry of the above amendment canceling Claim 2, Claims 1, 3-7, 10 and 13-24 will be pending.

In the prior Office Action, Claims 15 and 18-21 were indicated as allowable. However, as noted below, the current Office Action rejects previously allowed Claims 15 and 21 under Section 103(a) as obvious over Skiba. Applicant gratefully acknowledges the Examiner's continued indication of allowable subject matter in Claims 18-20.

Specification – Abstract of the Disclosure

Applicant has amended the Abstract to reduce its length to within 50 to 150 words. The original abstract had 179 words. The amended Abstract has 139 words.

Section 112 - Claim 2

Applicant has canceled claim 2 in light of the inclusion of the subject matter in previously amended Claim 1. Applicant respectfully submits that this deletion resolves the rejection under 35 U.S.C. 112, first paragraph.

Toy – 102(b) - Claims 1, 3-7, 10, 13 and 22-24

The Office Action rejects Claims 1, 3-7, 10, 13 and 22-24 under 35 U.S.C. 102(b) as anticipated by Toy.

In the prior Response, Applicant amended Claims 1 and 13 to require a needle tip that is ***integral*** with a bifurcated portion. Applicant acknowledges the Office Action's dictionary definition of ***integral*** as defining two things that are put together to form a whole, but respectfully notes that patent practitioners have commonly used *integral* to mean that two otherwise separable portions are inseparably formed from a common material – i.e. as a synonym for unitary.

However, in light of the Examiner's comments, Applicant has explicitly amended ***integral*** to ***unitary***. And, while Claim 22's step of "bifurcating the needle to form at least one pair of arms" inherently forms *unitary* arms in the sense that they are integrally formed from a common material, Applicant has explicitly amended Claim 22 to require the arms be unitary.

Based on the foregoing, Applicant respectfully submits that Claims 1, 3-7, 10, 13 and 22-24 are not anticipated by Toy.

Chu – 102(e) - Claims 1 and 3- 7

The Office Action continues to reject Claims 1 and 3-7 under 35 U.S.C. 102(e) as anticipated by Chu based on a new interpretation of Chu which regards the hook shaped portion (126) as one bifurcated portion and Chu's flap (128) as the other bifurcated portion.

Applicant respectfully submits that Claims 1 and 3-7 are not anticipated by Chu because Chu's flap (128) is pivotally connected to Chu's hook shaped portion (126) with a hinge (129)! Thus, in no way can the flap (126) and hook shaped portion (128) be regarded as bifurcated portions that are **unitary** with one another.

Based on the foregoing, Applicant respectfully submits that Claims 1 and 3-7 are not anticipated by Chu.

Diduch – 102(e) - Claims 13 and 22-24

The Office Action also continues to reject Claims 13 and 22-24 under 35 U.S.C. 102(e) as anticipated by Diduch. Claims 13 and 22 are the independent claims in this group of claims. Applicant respectfully traverses.

The Office Action appears to mistakenly interpret Diduch's Figures 2a and 2b as disclosing an apparatus according to Claim 13 or a method according to Claim 22.

The purpose of the Diduch device is to provide a needle that can be retracted into a straightening tube (20) for delivering to the surgical site (as shown in Figure 2a), and that that has an overall curve shaped when extended (as shown in Figure 2b). However, the Office Action mistakenly asserts that the slot 6 has a first slot

size in Figure 2a and a second larger slot size in Figure 2b. However, as made obvious by the relatively large diameter of the straightening tube 20, and the fact that **the slot 6 is the same size in both figures**, the straightening tube 20 does not compress the slot 6, it simply straightens out the overall needle assembly 10. The sides of the needle slot do not become more proximate or more separated.

Diduch's Figures 2a and 2b, therefore, do not teach or suggest the following claim elements (emphasis added):

Claim 13:

bifurcated portions of the needle assembly defining a suture slot, the bifurcated portions having **a proximate relationship** when the needle assembly is in the captured suture state and having **a separated relationship** when the needle assembly is in the free suture state;

Claim 22

bifurcating the needle to form at least one pair of arms defining a suture slot, with at least one arm being separated from the others at one of a distal end or a proximal end to permit suture to enter the suture slot, **the arms being movable between a proximate position associated with a first slot size and a spaced position associated with a second slot size** greater than the first slot size;

Based on the foregoing, Applicant respectfully submits that Claims 13 and 22-24 are not anticipated by Diduch.

Skiba – 103(a) - Claims 13, 15-17 and 21

Applicant gratefully acknowledges the Examiner's withdrawal of the prior rejection of Claims 1 and 22 under 35 U.S.C. 102(e) as anticipated by Skiba, but the

current Office Action still rejects Claims 13, 15-17 and 21 under 35 U.S.C. 103(a) as obvious over Skiba. In the prior response, Applicant amended the relevant portions of Claim 13 as follows:

a needle assembly having a needle movable in a needle housing between a free suture state, ~~and a captured suture state, and a locked suture state;~~

bifurcated portions of the needle assembly defining a suture slot, the bifurcated portions having a proximate relationship when the needle assembly is in the captured suture state and having a separated relationship when the needle assembly is in the free suture state;

In its newly applied obviousness analysis, and with reference to Figure 20 reproduced below with added hatching, the Office Action asserts that Skiba has “a needle (**2002**) movable in a needle housing (rest of **Figure 20**)” (emphasis in original):

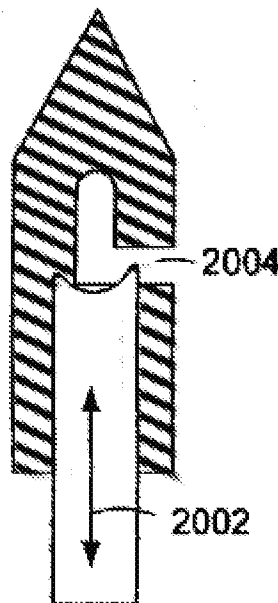


FIG. 20

However, the Skiba element identified by 2002 above is not a needle, but rather a “locking element”. How could the locking element be a needle given that it has a broad, blunt configuration at its end?

To be thorough, and as can be understood by reviewing Figures 19 and 20 together with the text at col. 4, lines 61-67, the locking element is actually item 1904. The 2002 is merely referring to an arrow that represents the back and forth motion of Figure 19’s “locking element” 1904.

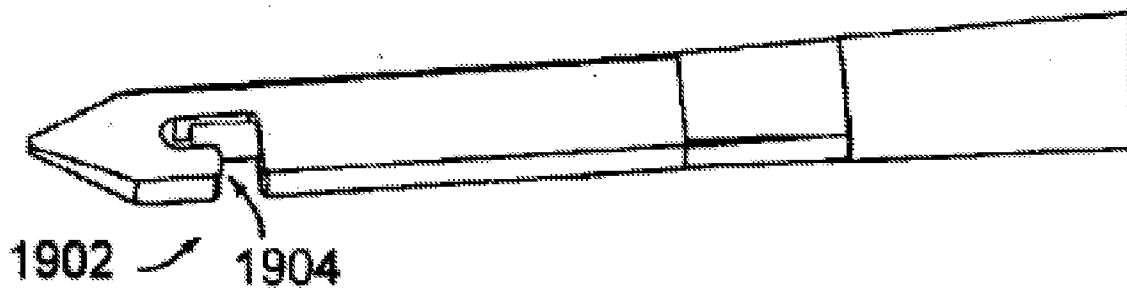


FIG. 19

Applicant respectfully notes that the invention of Claim 13 is not obvious over Skiba even if one were to regard the locking element 1904 as a “bifurcated portion” of a needle, and the rest of Figure 20 as the other “bifurcated portion” of the needle, because Claim 13 explicitly requires:

the bifurcated portions of the needle assembly being unitary with one another

Based on the foregoing, Applicant respectfully submits that Claims 13, 15-17 and 21 are not obvious over Skiba.

Withdrawn Claims

In light of the fact that the withdrawn Claims 8, 9, 11, 12 and 25-27 all depend from allowable claims, Applicant respectfully requests that the withdrawn claims be passed to issue as well.

Summary

It now appearing that this case is fully in condition for allowance as to Claims 1, 3-7, 10 and 13-24, and also as to previously withdrawn Claims 8, 9, 11, 12 and 25-27 , Applicant earnestly solicits a notice to that effect. Applicant invites the Examiner to call the undersigned attorney if it appears that a phone conference would further this case in any way.

Respectfully submitted,

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